

REMARKS

Claims 1-38 were pending in the present application. Claims 9, 12, 13, 22-28, and 31-38 were withdrawn from consideration. By virtue of this response, claims 2-4 have been canceled without, prejudice; claims 1, 5-6, 8, and 10-11, have been amended, and new claims 39-40 have been added which Applicant believes fall within the elected invention. Accordingly, claims 1, 5-8, 10-11, 14-21, 29-30 and 39-40 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Support for the amendment to claims can be found throughout the specification. New claim 39 finds support at least at paragraphs 0065-0066 and support for new claim 40 finds support at least at paragraph 0067.

Applicant requests rejoinder of methods claims to the extent they incorporate all the limitations of allowed composition claims. See *In re Ochiai*.

The Examiner states at page 3 of the Office Action that the present application was not filed on or after November 29, 2000. For the record, Applicant points out that the filing date of the present application is July 13, 2001 and the application has published.

Regarding the Specification

The specification has been amended to correct an inadvertent typographical error.

Rejection of claims under 35 U.S.C. § 102(b)

A. Clams 1-8, 10, 14-16, 18-21, and 29 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Matthews et al. *Journal of General Virology* (1999) 80, 345-353 (“Matthews”).

Applicant traverses this rejection of claims.

In order to anticipate a claim, a single source must contain all the elements of the claim. Independent claim 1 recites a bovine adenovirus vector comprising an intron and a heterologous transgene wherein said intron is located 5' to the heterologous transgene, and wherein said vector is capable of expressing greater levels of the heterologous transgene than a comparable bovine adenovirus vector comprising the heterologous transgene and lacking an intron 5' to said heterologous transgene. Matthews does not teach the presently claimed invention, that is, a bovine adenovirus vector comprising an intron and a heterologous transgene Therefore, each and every element of the claimed invention is not present in Matthews and as a matter of law, Matthews cannot anticipate the claimed invention.

Applicant respectfully requests withdrawal of this rejection of claims.

B. Claims 1-8, 10, 11, 14-21, 29, and 30 stand rejected under 35 U.S.C § 102(e) as allegedly being anticipated by Mehtali et al. (Patent No. 6,479,290 B1).

Applicant traverses this rejection of claims. Each and every element of the presently claimed invention is not present in U.S. Patent No. 6,479,290.

U.S. Patent No. 6,479,290 has no teachings of a bovine adenovirus vector comprising an intron and a heterologous transgene wherein said intron is located 5' to the heterologous transgene, and wherein said vector is capable of expressing greater levels of the heterologous transgene than a comparable bovine adenovirus vector comprising the heterologous transgene and lacking an intron 5' to said heterologous transgene. Therefore, as a matter of law, U.S. Patent No. 6,479,290 can not anticipate the presently claimed invention.

Applicant respectfully requests withdrawal of this rejection of claims.

C. Claims 1-8, 10, 11, 14-21, 29, and 30 stand rejected under 35 U.S. C. § 102(b) as allegedly being anticipated by Lusky et al. (WO99/61638).

Applicant traverses this rejection of claims. Each and every element of the presently claimed invention is not present in WO99/61638. Applicants point out that U.S. Patent No. 6,479,290 appears to be filed under Section 371 based on WO99/61638. WO99/61638 has no teachings of a bovine adenovirus vector comprising an intron and a heterologous transgene wherein said intron is located 5' to the heterologous transgene, and wherein said vector is capable of expressing greater levels of the heterologous transgene than a comparable bovine adenovirus vector comprising the heterologous transgene and lacking an intron 5' to said heterologous transgene. Therefore, as a matter of law, WO99/61638 can not anticipate the presently claimed invention.

Applicant respectfully requests withdrawal of this rejection of claims.

D. Claims 1-8, 10, 11, 14-21, 29, and 30 stand rejected under Section 102(b) as allegedly being anticipated by FR2642767.

Applicant traverses this rejection. Each and every element of the claimed invention is not present in FR2642767. There is no disclosure in FR2642767 of a bovine adenovirus vector comprising an intron and a heterologous transgene wherein said intron is located 5' to the heterologous transgene, and wherein said vector is capable of expressing greater levels of the heterologous transgene than a comparable bovine adenovirus vector comprising the heterologous transgene and lacking an intron 5' to said heterologous transgene. Therefore, as a matter of law, this rejection of claims must fail. Applicant respectfully requests withdrawal of this rejection of claims.

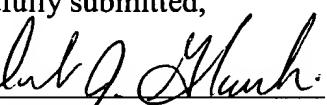
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 293102002900. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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